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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,951	11/13/2003	Larry J. Pacey	WMS-029	9624
30223	7590	06/20/2007		
NIXON PEABODY LLP 161 N. CLARK STREET 48TH FLOOR CHICAGO, IL 60601-3213			EXAMINER LEUNG, JENNIFER	
			ART UNIT 3714	PAPER NUMBER
			MAIL DATE 06/20/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/712,951	Applicant(s) PACEY, LARRY J.	
	Examiner Jennifer Leung	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/2/2005;11/13/2003</u> | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Objections

1. Claims 5 and 18 objected to because of the following informalities:

Claims 5 and 8: "wining" should be -- winning --.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. **Claims 1-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Marks (US 2003/0157981).**

Re claim 1. Marks discloses a method of conducting a wagering game on a gaming machine, comprising: receiving a wager from a player to initiate play of the wagering game (para. 0018); randomly selecting a plurality of symbols to form a first array (para. 0018); displaying the first array (para. 0018); identifying winning symbols in the first array that form any first winning combination (para. 0019); awarding the player for the first winning combination in the first array (para. 0019); replacing one or more of the

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winning symbols in the first array that form the first winning combination with a randomly determined replacement symbol to form a second array (para. 0019); displaying the second array (para. 0019); identifying winning symbols in the second array that form any second winning combination (para. 0019); and awarding the player for the second winning combination in the second array (para. 0019).

Re claim 2. Marks discloses wherein less than all of the winning symbols that form the first winning combination are replaced (para. 0089).

Re claim 3. Marks discloses wherein a wild symbol is one of the winning symbols forming the first winning combination (para. 0085-86) and is not replaced (para. 0089).

Re claim 4. Marks discloses wherein the first winning combination occurs on an active pay line (para. 0004).

Re claims 5 and 6. See rejections of claims 2-3 for features of claims 5 and 6.

Re claim 7. Marks discloses a method of conducting a wagering game on a gaming machine, comprising: receiving a wager from a player to initiate play of the wagering game (para. 0018); randomly selecting a plurality of symbols to form a first array (para. 0018); displaying the first array (para. 0018); identifying any first winning pay line (para. 0004 and 0019); awarding the player for the first winning pay line in the first array (para.

0004 and 0019); randomly determining a replacement symbol for each of the symbols on the first winning pay line in the first array (para. 0052); replacing one or more of the symbols on the first winning pay line in the first array with the randomly determined replacement symbols to form a second array (para. 0077); displaying the second array (para. 0019); and awarding the player for any second winning pay line in the second array (para. 0019).

Re claims 8 and 9. See rejections of claims 2-3 for features of claims 8 and 9.

Re claim 10. Marks discloses a method of conducting a wagering game on a gaming machine, comprising: receiving a wager from a player to initiate play of the wagering game (para. 0018); randomly selecting a plurality of symbols to form a first array (para. 0018); displaying the first array (para. 0018); identifying a first winning symbol in the first array that creates any first winning outcome (para. 0019); awarding the player for the first winning outcome (para. 0019); replacing the first winning symbol with a randomly determined first replacement symbol to form a second array (para. 0019); displaying the second array (para. 0019); identifying a second winning symbol in the second array that creates any second winning outcome (para. 0019); and awarding the player for the second winning outcome (para. 0019).

Re claim 11. Marks discloses further including: replacing the second winning symbol with a randomly determined second replacement symbol to form a third array (para.

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0019); displaying the third array (para. 0019); identifying a third winning symbol in the third array that forms any third winning outcome (para. 0019); and awarding the player for the third winning outcome (para. 0019).

Re claim 12. Marks discloses a method of conducting a wagering game on a gaming machine, comprising: receiving a wager from a player to initiate play of the wagering game (para. 0018); randomly selecting a plurality of symbols to form a first array (para. 0018); displaying the first array (para. 0018); identifying at least one start-bonus symbol in the first array (para. 0005); replacing each start-bonus symbol with a randomly determined replacement symbol to form a second array (para. 0019); displaying the second array (para. 0019); identifying any winning bonus game outcome in the second array (para. 0019); and awarding the player for the winning bonus game outcome (para. 0019).

Re claim 13. Marks discloses further including: identifying a winning basic game outcome in the first array (para. 0019); and awarding the player for the winning basic game outcome (para. 0019).

Re claim 14. Marks discloses a method of conducting a wagering game on a gaming machine, comprising: receiving a wager from a player to initiate play of the wagering game (para. 0018); randomly selecting a plurality of symbols to form a first array (para. 0018); displaying the first array (para. 0018); identifying winning symbols in the first

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array that form a scatter pay (para. 0019 and 0087-88); awarding the player for the scatter pay in the first array (para. 0088); replacing each of the winning symbols with a randomly determined replacement symbol to form a second array (para. 0019); displaying the second array (para. 0019); and awarding the player for a winning outcome in the second array (para. 0019).

Re claims 15 and 16. See rejections of claims 2-3 for features of claims 15 and 16.

Re claim 17. Marks discloses wherein the winning symbols forming the scatter pay must occur on an active pay line (para. 0004 and 0087).

Re claims 18 and 19. See rejections of claims 2-3 for features of claims 18 and 19.

Conclusion


3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Adams discloses a game with reservable wild indicia. Glavich discloses a gaming device having different sets of primary and secondary reel symbols.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer Leung whose telephone number is 571-270-1342. The examiner can normally be reached on Mon -Thur, every other Fri.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on 571-272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Jennifer Leung
June 16, 2007


Robert E. Pezzuto
Supervisory Patent Examiner
Art Unit 3714